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Geno Munari

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29747

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EXAMINER

NEGRON, ISMAEL

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/648,655	Applicant(s) MUNARI, GENO	
	Examiner Ismael Negron	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12 and 14-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12 and 14-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on April 24, 2006 has been entered. Claims 1, 4, 9, 15, 19, 22, 26 and 31 have been amended. No claims has been cancelled, or added. Claims 1-5, 7-12 and 14-34 are still pending in this application, with claims 1, 9, 15, 19, 26 and 31 being independent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 8, 9 and 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by VAAGENES (U.S. Pat. 4,093,973).
3. VAAGENES discloses an illumination device having:
- **a housing (as recited in claims 1 and 9),** Figure 2, reference number 10;
 - **a light source (as recited in claims 1 and 9),** Figure 2, reference number 22;
 - **the light source being located within the housing (as recited in claims 1 and 9),** column 2, lines 33-38;

- **a power source (as recited in claims 1 and 9), Figure 2, reference number 24;**
- **the power source being located within the housing (as recited in claims 1 and 9), column 2, lines 33-38;**
- **means for intermittently activating the light source (as recited in claims 1 and 9), Figure 2, reference number 26;**
- **the means for intermittently activating the light source including a button (as recited in claims 1 and 9), Figure 2, reference number 26;**
- **the button extending from a bottom portion of the housing (as recited in claims 1 and 9), as seen in Figure 2;**
- **the button being in contact with a non-tip portion of a human finger on which the device is attached (as recited in claims 1 and 9), as evidenced by Figure 2;**
- **a resilient strap (as recited in claims 1 and 9), Figure 1, reference number 12;**
- **the resilient strap being for removably attaching the housing to the human finger (as recited in claims 1 and 9), column 1, lines 64 and 65;**
- **a portion of emitted light being normal to the finger when activated (as recited in claims 1 and 9), inherent as evidenced by Figure 2;**

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- **the light source being activated by applying pressure to the button (as recited in claims 4 and 9), column 2, lines 48-52;**
- **the button being exposed near a first end of the housing (as recited in Claim 4), as seen in Figure 2;**
- **the light source being activated as long as pressure is applied to the button (as recited in Claim 4), column 2, lines 48-52; and**
- **the housing being translucent (as recited in Claim 8), column 2, lines 65-68.**

4. Method claims 15 and 17 were considered as inherently disclosed by the patented structure of VAAGENES, as detailed in Section 3, above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 7, 10, 11, 14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over VAAGENES (U.S. Pat. 4,093,973).

6. VAAGENES discloses an illumination device having:

- **a housing (as recited in claims 1 and 9), Figure 2, reference number 10;**
- **a light source (as recited in claims 1 and 9), Figure 2, reference number 22;**
- **the light source being located within the housing (as recited in claims 1 and 9), column 2, lines 33-38;**
- **a power source (as recited in claims 1 and 9), Figure 2, reference number 24;**
- **the power source being located within the housing (as recited in claims 1 and 9), column 2, lines 33-38;**
- **means for intermittently activating the light source (as recited in claims 1 and 9), Figure 2, reference number 26;**
- **the means for intermittently activating the light source including a button (as recited in claims 1 and 9), Figure 2, reference number 26;**
- **the button extending from a bottom portion of the housing (as recited in claims 1 and 9), as seen in Figure 2;**
- **the button being in contact with a non-tip portion of a human finger on which the device is attached (as recited in claims 1 and 9), as evidenced by Figure 2;**

- **a resilient strap (as recited in claims 1 and 9), Figure 1, reference number 12;**
- **the resilient strap being for removably attaching the housing to the human finger (as recited in claims 1 and 9), column 1, lines 64 and 65;**
- **a portion of emitted light being normal to the finger when activated (as recited in claims 1 and 9), inherent as evidenced by Figure 2; and**
- **the light source being activated by applying pressure to the button (as recited in Claim 9), column 2, lines 48-52.**

7. VAAGENES discloses all the limitations of the claims, except:

- the light source being a light emitting diode (as recited in claims 2 and 10);
- the power source being a lithium battery (as recited in claims 3 and 11); and
- the housing having a flesh-colored covering (as recited in claims 7 and 14).

8. The examiner takes Official Notice that the use of light emitting diodes (LED) is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute an LED for the incandescent or fluorescent light source of the device of VAAGENES (as recited in

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claims 2 and 10). One would have been motivated since LEDs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over the incandescent or fluorescent light sources of VAAGENES.

Evidenced of such old and well known in the art status of LED can be found in the Prior Art already made of record.

9. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a lithium battery (as recited in claims 3 and 11) as the battery disclosed by VAAGENES, since the Examiner takes Official Notice that the use of lithium batteries is old and well known in the illumination art (as admitted by the applicant). One would have been motivated since lithium batteries are recognized to have many desirable advantages, including reduced size, high efficiency, and high power production, over other batteries.

10. Regarding claims 7 and 14, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include a flesh-colored sheath for covering the housing of VAAGENES (as recited in claims 7 and 14), since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, one would have been motivated to include the claimed flesh-colored sheath to obtain a flesh

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colored device, as necessitated by the specific aesthetic requirements of a particular application.

11. Method claims 16 and 18 were considered as inherently disclosed, or at least suggested, by the patented structure of VAAGENES, as detailed in sections 8 and 10, above.

12. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over VAAGENES (U.S. Pat. 4,093,973) in view of DION (U.S. Pat. 5,934,784).

13. VAAGENES discloses an illumination device having:

- **a housing (as recited in claims 1 and 9)**, Figure 2, reference number 10;
- **a light source (as recited in claims 1 and 9)**, Figure 2, reference number 22;
- **the light source being located within the housing (as recited in claims 1 and 9)**, column 2, lines 33-38;
- **a power source (as recited in claims 1 and 9)**, Figure 2, reference number 24;
- **the power source being located within the housing (as recited in claims 1 and 9)**, column 2, lines 33-38;

- **means for intermittently activating the light source (as recited in claims 1 and 9), Figure 2, reference number 26;**
- **the means for intermittently activating the light source including a button (as recited in claims 1 and 9), Figure 2, reference number 26;**
- **the button extending from a bottom portion of the housing (as recited in claims 1 and 9), as seen in Figure 2;**
- **the button being in contact with a non-tip portion of a human finger on which the device is attached (as recited in claims 1 and 9), as evidenced by Figure 2;**
- **a resilient strap (as recited in claims 1 and 9), Figure 1, reference number 12;**
- **the resilient strap being for removably attaching the housing to the human finger (as recited in claims 1 and 9), column 1, lines 64 and 65;**
- **a portion of emitted light being normal to the finger when activated (as recited in claims 1 and 9), inherent as evidenced by Figure 2; and**
- **the light source being activated by applying pressure to the button (as recited in Claim 9), column 2, lines 48-52.**

14. VAAGENES discloses all the limitations of the claims, except the resilient strap being elastic (as recited in claims 5 and 12).

15. DION discloses an illumination device having:

- **a housing (as recited in claims 1 and 9),** Figure 1, reference number 10;
- **a light source (as recited in claims 1 and 9),** Figure 1, reference number 34;
- **the light source being located within the housing (as recited in claims 1 and 9),** as seen in Figure 1;
- **a power source (as recited in claims 1 and 9),** Figure 1, reference number 26;
- **the power source being located within the housing (as recited in claims 1 and 9),** as seen in Figure 1;
- **means for intermittently activating the light source (as recited in claims 1 and 9),** Figure 2, reference number 38;
- **a resilient strap (as recited in claims 1 and 9),** Figure 1, reference number 16; and
- **the resilient strap being elastic (as recited in claims 5 and 12),** column 2, line 55.

16. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to replace the resilient strap of VAAGENES with the elastic strap of DION to enable the patented device of VAAGENES to be removably attached to fingers of different sizes and shapes, as evidenced by DION.

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17. Claims 19, 20, 22, 25-27 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over GONG-HWA (U.S. Pat. 5,622,062) in view of VAAGENES (U.S. Pat. 4,093,973).

18. GONG-HWA discloses an illumination device having:

- **a housing (as recited in claims 19 and 26)**, Figure 2, reference number 10;
- **a light source (as recited in claims 19 and 26)**, Figure 2, reference number 30;
- **the light source being located within the housing (as recited in claims 19 and 26)**, as seen in Figure 2;
- **a power source (as recited in claims 19 and 26)**, Figure 2, reference number 33;
- **the power source being located within the housing (as recited in claims 19 and 26)**, as seen in Figure 2;
- **means for intermittently activating the light source (as recited in claims 19 and 26)**, Figure 2, reference number 30;
- **the means for intermittently activating the light source including a button (as recited in claims 19 and 26)**, Figure 3, reference characters SW1;
- **two or more flexible members (as recited in claims 19 and 26)**, Figure 2, reference number 11;

- **the flexible members being for removably attaching the housing to a human finger (as recited in claims 19 and 26),**
column 1, lines 64-66;
- **a portion of emitted light being normal to the finger when activated (as recited in claims 19 and 26),** inherent as evidenced by Figure 1;
- **the light source being a light emitting diode (as recited in claims 20 and 27),** column 2, lines 8 and 9;
- **the light source being activated by applying pressure to the button (as recited in Claim 22),** column 2, lines 18-24;
- **the button being exposed near a first end of the housing (as recited in Claim 22),** as evidenced by column 2, lines 27-30;
- **the light source being activated as long as pressure is applied to the button (as recited in Claim 22),** column 2, 18-24; and
- **the housing being translucent (as recited in Claim 25),** as evidenced by column 2, lines 33-35.

19. GONG-HWA discloses all the limitations of the claims, except:

- the button extending from a bottom portion of the housing (as recited in claims 19 and 26); and
- the button being in contact with a non-tip portion of a human finger on which the device is attached (as recited in claims 19 and 26).

20. VAAGENES discloses an illumination device having:

- **a housing (as recited in claims 19 and 26)**, Figure 2, reference number 10;
- **a light source (as recited in claims 19 and 26)**, Figure 2, reference number 22;
- **the light source being located within the housing (as recited in claims 19 and 26)**, column 2, lines 33-38;
- **a power source (as recited in claims 19 and 26)**, Figure 2, reference number 24;
- **the power source being located within the housing (as recited in claims 19 and 26)**, column 2, lines 33-38;
- **means for intermittently activating the light source (as recited in claims 19 and 26)**, Figure 2, reference number 26;
- **the means for intermittently activating the light source including a button (as recited in claims 19 and 26)**, Figure 2, reference number 26;
- **the button extending from a bottom portion of the housing (as recited in claims 19 and 26)**, as seen in Figure 2; and
- **the button being in contact with a non-tip portion of a human finger on which the device is attached (as recited in claims 19 and 26)**, as evidenced by Figure 2.

21. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include, in the switch structure of GONG-HWA, the button arrangement of VAAGENES, such button arrangement including a button extending from a bottom portion of the housing for contacting a non-tip portion of a human finger on which the device is attached (as recited in claims 19 and 26), to enable the patented illumination device of GONG-HWA to be turned ON and OFF automatically, by attaching it and removing it from a human finger, as per the teachings of VAAGENES (see column 2, lines 48-52).

22. Method claims 31-33 were considered as inherently disclosed by the patented structure of GONG-HWA, or suggested by the combined teachings of GONG-HWA and VAAGENES, as detailed in sections 18-21, above.

23. Claims 21, 24, 28, 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over GONG-HWA (U.S. Pat. 5,622,062) in view of VAAGENES (U.S. Pat. 4,093,973).

24. GONG-HWA discloses individually, or suggest in combination with VAAGENES, all the limitations of the claims (as detailed in previous sections 17-22), except the battery being a lithium battery (as recited in claims 21 and 28), or a flesh-colored sheath for covering the housing (as recited in claims 24 and 30).

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25. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a lithium battery (as recited in claims 21 and 28) as the battery disclosed by GONG-HWA, since the Examiner takes Official Notice that the use of lithium batteries is old and well known in the illumination art (as admitted by the applicant). One would have been motivated since lithium batteries are recognized to have many desirable advantages, including reduced size, high efficiency, and high power production, over other batteries.

26. Regarding Claim 24, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include a flesh-colored sheath for covering the housing of GONG-HWA (as recited in claims 24 and 30), since the courts have stated that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In this case, one would have been motivated to include the claimed flesh-colored sheath to obtain a flesh colored device, as necessitated by the specific aesthetic requirements of a particular application.

27. Method Claim 34 was considered as inherently disclosed, or suggested, by the combined teachings of GONG-HWA and VAAGENES (as detailed in sections 25 and 26, above).

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28. Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over GONG-HWA (U.S. Pat. 5,622,062) in view of VAAGENES (U.S. Pat. 4,093,973).

29. GONG-HWA disclose individually, or suggest in combination with VAAGENES, all the limitations of the claims (as detailed in previous sections 17-22), except the flexible members being metallic (as recited in claims 23 and 29).

30. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a metallic material for the flexible members of GONG-HWA (as recited in claims 23 and 29), since it has been held by the courts that selection of a prior art material on the basis of its suitability for its intended purpose is within the level of ordinary skill. *In re Leshing*, 125 USPQ 416 (CCPA 1960) and *Sinclair & Carroll Co. v. Interchemical Corp.*, 65 USPQ 297 (1945). In this case, any resilient material could be used to attach the device to a support structure, as admitted by the applicant (see paragraph 0015, lines 6 and 7 of the specification as originally filed).

Response to Arguments

31. Applicant's arguments filed on April 24, 2006 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (703) 308-6086. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (703) 305-4939. The facsimile machine number for the Art Group is (571) 273-8300.

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35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



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